

REMARKS

The Examiner rejected claims 1-4, 6-16 and 18-25 under 35 U.S.C. §103(a) as allegedly being unpatentable over US Pat No 5,819,251 issued to Kremer et al. (hereafter Kremer '251) in view of US Pat No. 6,615,223 issued to Shih et al. (hereafter Shih).

The Examiner rejected claims 5 and 17 under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Kremer '251 and Shih and further in view of Pub No US 2003/0200197 issued to Long et al. (hereafter Long '197).

Applicants respectfully contend that the finality of the present office action is improper, because the Examiner has rejected claims 1-3, 6-15, and 18-25 under 35 U.S.C. §103(a) over Kremer in view of Shih, which is a new ground of rejection not necessitated by amendment of the claims. Accordingly, Applicants respectfully request that the present office action be changed from a final office action to a non-final office action.

Applicants respectfully traverse the §103 rejections with the following arguments.

35 U.S.C. §103(a)

The Examiner rejected claims 1-4, 6-16 and 18-25 under 35 U.S.C. §103(a) as allegedly being unpatentable over US Pat No 5,819,251 issued to Kremer et al. (hereafter Kremer '251) in view of US Pat No. 6,615,223 issued to Shih et al. (hereafter Shih).

Applicants respectfully contend that claims 1, 13, and 25 are not unpatentable over Kremer '251 in view of Shih, because Kremer '251 in view of Shih does not teach or suggest each and every feature of claims 1, 13, and 25.

As a first example illustrating that Kremer '251 in view of Shih does not teach or suggest each and every feature of claims 1, 13, and 25, Kremer '251 in view of Shih does not teach or suggest the following feature of claim 1 (and similarly for claims 13 and 25): "creating the template based on design information, said creating the template implemented by a template manager".

The Examiner argues that Kremer '251 discloses: "creating the template [data dictionary 130, Fig 3, col 8, lines 53-60 and col 9, lines 1-7] based on design information, said creating the template implemented by a template manager [RDMS 18, Fig 2]". In other words, the Examiner argues that the data dictionary 130 is a template that is created by the template manager of RDMS 18.

In response, Applicants contend that Kremer does not disclose that the RDBMS 18 creates the data dictionary 130. Kremer discloses the functionality of the RDBMS 18 in col. 5, lines 34-35: "RDBMS 18 stores, retrieves and analyzes objects created by application 14 ", which does not disclose that the RDBMS 18 creates the data dictionary 130. In fact, Kremer discloses only the existence of the data dictionary 130. Kremer is totally silent as to who creates

the data dictionary, and Kremer is totally silent as to how the data dictionary is created.

As a second example illustrating that Kremer '251 in view of Shih does not teach or suggest each and every feature of claims 1, 13, and 25, Kremer '251 in view of Shih does not teach or suggest the following feature of claim 1 (and similarly for claims 13 and 25): "storing the template in a template manager database, said storing the template implemented by the template manager".

The Examiner argues that Kremer '251 discloses: "storing the template in a template manager database, said storing the template implemented by the template manager [col 8, lines 53-60]".

In response, Applicants contend that the Examiner has not identified a template manager database in Kremer '251. Applicants note that col 8, lines 53-60 of Kremer '251 identify only the data dictionary 130 which the Examiner has previously identified as the template of claims 1, 13, and 25. Applicants assert that col 8, lines 53-60 of Kremer '251 does not identify a template manager database. Therefore, based on the Examiner's assertion that the data dictionary 130 is a template, it is clear that the data dictionary 130 cannot be a template manager database.

In addition, claims 1, 13, and 25 require **storing** the template in the template manager database, and col 8, lines 53-60 of Kremer '251 does not disclose storing the template. Col 8, lines 53-60 of Kremer '251 discloses storing only preferences for non-relational data components which is not the template according to the Examiner, since the Examiner has identified the data dictionary 130 as the template.

As a third example illustrating that Kremer '251 in view of Shih does not teach or suggest each and every feature of claims 1, 13, and 25, Kremer '251 in view of Shih does not teach or suggest the following features of claim 1 (and similarly for claims 13 and 25): "generating the N instances based on the template and on control information for the N instances, said control information including configuration control information, said configuration control information identifying N locations corresponding to the N instances, said N at least 2, said generating the N instances implemented by the template manager; storing the N instances in the template manager database, said storing the N instances implemented by the template manager; and transmitting the N instances to the corresponding N locations, said transmitting the N instances implemented by the template manager".

The Examiner argues that Shih discloses: "generating the N instances based on the template and on control information for the N instances, said control information including configuration control information, said configuration control information identifying N locations corresponding to the N instances, said N at least 2, said generating the N instances implemented by the template manager; ... storing the N instances in the template manager database, said storing the N instances implemented by the template manager; and transmitting the N instances to the corresponding N locations, said transmitting the N instances implemented by the template manager".

In response, Applicants contend that the Examiner has not provided any analysis of Shih to support the Examiner's contention that Shih discloses the aforementioned generating, storing, and transmitting features of claims 1, 13, and 25. For example, the Examiner has not identified any instances, template, configuration control information, and template manager in Shih.

Moreover, the Examiner has not provided any citation in Shih that allegedly discloses said generating, storing, and transmitting features of claims 1, 13, and 25. To merely allege, without any supporting analysis, that Shih discloses the aforementioned generating, storing, and transmitting features of claims 1, 13, and 25 (with respect to the claimed instances, template, configuration control information, and template manager) does not satisfy the Examiner's burden to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) and represents an attempt to improperly shift the initial burden of proof to Applicants.

In addition, Applicants contend that the Examiner's argument for modifying Kremer '252 with the alleged teaching of Shih is not persuasive. The Examiner argues: "The ordinary skilled artisan would have been motivated to modify Kremer '251 per the above as taught by Shih for the purpose of making available the RDMS at a plurality of client sites for the particular use of the client." In response, Applicants contend that a RDMS could be made available at a plurality of client sites without use of the preceding features of claims 1, 13, and 25. For example, a RDMS on a central server may be made available to a plurality of client workstations or personal computers which are connected to the central server, independent of the preceding features of claims 1, 13, and 25.

Moreover, the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Kremer by the alleged teaching of Shih in relation to claims 1, 13, and 25. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf*

Co., 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**"). The Examiner has not made any showing of where the prior art suggests making available the RDMS at a plurality of client sites for the particular use of the client. Thus, the Examiner has provided a reason for the combination by speculation, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for making available the RDMS at a plurality of client sites for the particular use of the client, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 1, 13, and 25.

Based on the preceding arguments, Applicants respectfully maintain that claims 1, 13, and 25 are not unpatentable over Kremer '251 in view of Shih, and that claims 1, 13, and 25 are in condition for allowance. Since claims 2-12 depend from claim 1, Applicants contend that claims 2-12 are likewise in condition for allowance. Since claims 14-24 depend from claim 1, Applicants contend that claims 14-24 are likewise in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below.

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